

Patent
Attorney's Docket No. 000600-033

REMARKS

The Examiner has maintained the rejections under 35 U.S.C. § 103 over Nakayama et al in combination with Miller.

As pointed out in the response to the initial Office Action, the present invention solves the problem of providing an efficient method of eliminating or reducing residual monomers in or on expandable microspheres without unacceptable discoloration by contacting them with a certain kind of sulfur containing chemical agent as defined in the claims.

The Examiner has alleged that the problems of discoloration and/or bad smell involved with using sulfate or sulfides as disclosed in Nakayama are well known and that it therefore would be obvious to a person skilled in the art to replace these chemicals for those disclosed in Miller.

However, if it is correct that the problems of using sulfates or sulfides are well known, the evidence for non-obviousness of the present invention is certainly strengthened. It should be noted that Nakayama et al has spent significant effort in finding a suitable way of preparing expandable microspheres with reduced amount of residual monomer and tested a large number of chemical substances, but come to the conclusion that sulfides are particularly preferred in spite of the well known problems of discoloration and bad smell. If the substances of Miller were believed to be suitable for treating expandable microspheres they would certainly have been disclosed in Nakayama et al in favor of the sulfides that according to the Examiner would be expected to be disadvantageous. Furthermore, as there is no hint whatsoever in Miller that the compounds disclosed therein would be suitable for treatment of expandable microspheres, a person of ordinary skill in the art would have no reason at all to believe so, particularly in view

Patent
Attorney's Docket No. 000600-033

of the extensive work relating to microspheres already done by Nakayama et al. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness.

Regarding claims 18 and 19, the Examiner maintains that the compounds claimed as being present in or on the microspheres are known emulsifiers disclosed in Miller and therefore inherently included in the product. Applicants disagree.

First, the Examiner is requested to identify which of the emulsifiers disclosed in Miller fall within the formulas of claims 18 and 19. Secondly, if Miller discloses one or more of the claimed compounds as an emulsifier, there would certainly be no reason for a person skilled in the art to include such an emulsifier in expandable microspheres as disclosed in Nakayama et al. Although emulsifiers are usually employed when preparing lattices as disclosed in Miller, there is no suggestion in Nakayama et al to use any kind of emulsifier when preparing expandable microspheres. Thus, a person skilled in the art would have no motivation whatsoever to employ any of the emulsifiers disclosed in Miller for the preparation or treatment of the microspheres disclosed in Nakayama et al.

Accordingly, claims 18 and 19 cannot possibly be obvious to a person of ordinary skill in the art with knowledge of the cited references.

Patent
Attorney's Docket No. 000600-033


In view of the above, applicants respectfully request that a timely Notice of Allowance be issued in this case.

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Respectfully submitted,

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